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Application No. 10/825,405
Amendment dated June 2, 2008
Reply to Office Action of May 29, 2008

JUL 02 2008

Docket No.: NY-NIAD 216-US2-DIV

REMARKS

Entry of the amendment is requested, whereby claims 13-21 will remain pending.

Applicants first turn to the prior art rejections. The first is an anticipation invention in view of Scivoletto.

The Examiner admits that Scivoletto only exemplifies methyl nicotinate, which is excluded from the claims.

Regarding the second rejection, the Examiner cites to Warshaw, which teaches "nicotinic acid esters containing 7-12 carbon atoms," and notes that nicotinic acid has 6 carbon atoms.

It is not understood why claim 18 is included in this rejection. The claim specifies that the alkyl chain of the ester contains 12 or 14 carbon atoms. This being, the case, the molecule contains 18 carbon atoms, outside of the prior art.

In fact, amended claims 13 present compounds containing at least 14 carbon atoms. Again, the claims are outside of the reference.

As to Bernstein, the Examiner appears to take the position that nicotinamide - which is NOT a nicotinic acid alkyl ester - as described in Bernstein, anticipates the claims because it contains 6 carbon atoms. Even without amendment, Bernstein is not an appropriate reference. The rejection was improper and should be withdrawn.

The Examiner then presents an obviousness rejection of claims 13, 15, and 18-21 in view of Scivoletto, but only seems to address the use of mixtures, as per claim 21. Scivoletto does not teach anything other than methyl nicotinic acid alkyl ester. Nothing in Scivoletto suggests the longer chain nicotinic acid alkyl ester now claimed.

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It is also noted that the Examiner feels that the claimed invention is an obvious variation of the invention claimed in issued U.S. Patent No. 6,750,234. The claims of the '234 patent were all patentable over all of the references cited in this current action. The Examiner's position is self-contradictory: prior art rejection of, e.g., claim 18, cannot be reconciled with an obviousness type double patenting rejection as was made. Hence, applicants cannot address the double patenting rejection at this time, as it appears to be in error, and clarification is necessary.

Withdrawal of the rejections, and allowance of claims 13-21 is believed proper and is urged.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-0624, under Order No. NY-NIAD 216-US2-DIV (104047460 from which the undersigned is authorized to draw.

Dated: June 2, 2008

Respectfully submitted,

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